

REMARKS

This communication responds to the Office Action dated January 23, 2008. Claims 1, 7, 9, 12, 16-17, 19, 23, and 24-25 are amended, claim 26 is canceled, and no claims are added. As a result, claims 1, 4-7, 9-14, 16-17, 19, 22-25, and 27-29 are now pending in this Application.

It is respectfully noted that dependent claims 16, 19, and 24 have been amended to conform to the language of their respective amended independent claims, and not for reasons related to patentability. Claim 9 has been amended to correct a typographical error, and not for reasons related to patentability.

§102 Rejection of the Claims

Claims 1, 4-7, 9-11, 17, 19, 22, and 24-29 were rejected under 35 U.S.C. § 102(e) for anticipation by Zigmond (U.S. Patent No. 6,698,020; hereinafter “Zigmond”). The Applicant does not admit that Zigmond is prior art, and reserves the right to swear behind this reference in the future. In addition, since the Examiner has not established a *prima facie* case of anticipation with respect to independent claims 1, 7, 17, 23, and 25, the Applicant respectfully traverses.

1) The Applicable Law

It is respectfully noted that anticipation under 35 USC § 102 requires the disclosure in a single prior art reference of each element of the claim under consideration. *See Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added). “The *identical invention* must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); MPEP § 2131 (emphasis added).

2) *Application of § 102 to The Rejected Claims – The Cited Reference Does Not Teach or Suggest the Presence of All Claim Elements:*

Independent claims 1, 7, 17, and 23 have been amended to recite “disabling at least one previously-enabled size control function of said display window”. Independent claim 25 has been amended to recite “wherein at least one previously-enabled size control function of the display window is disabled”. This language is supported by the text of the Application, as originally filed, at least at page 3, line 29, and at page 9, lines 4-5. Thus, no new matter has been added.

The Office asserts that “Zigmond inherently teaches adjusting the display window to full-screen size.” If the Office relies on inherency then, as recited in MPEP § 2112, “... the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art,” citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). No such basis has been provided. In fact, there is no technical reason why the display window could not be presented as a full screen without any size adjustment whatsoever. Indeed, if the full screen size is always used, this is the most likely situation. In other words, the Applicant was unable to find any indication of screen size adjustment capability, as claimed by the Applicant, within the bounds of Zigmond.

Further, the Applicant was unable to find any teaching or suggestion within the bounds of Zigmond pertaining to disabling a previously-enabled display window size control function, as claimed by the Applicant in each of the independent claims. Dependent claims 4-6, 9-11, 19, 22, 24, and 27-29 contain additional, patentable subject matter.

Therefore, since no *prima facie* case of anticipation has been established with respect to Zigmond, the Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1, 4-7, 9-11, 17, 19, 22, and 24-29 under 35 U.S.C. § 102(e).

§103 Rejection of the Claims

Claims 12-14 and 16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Siler (U.S. Patent Application Publication No. 2004/0133467 A1; hereinafter “Siler”) in view of Bates (U.S. Patent No. 6,342,908 B1; hereinafter “Bates”) and further in view of Dwek (U.S.

Patent Application Publication No. 2001/0018858 A1; hereinafter “Dwek”). Claim 23 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Zigmond in view Dwek. However, since a *prima facie* case of obviousness has not been established by the Office in each case, the Applicant respectfully traverses the rejection of these claims.

1) The Applicable Law

As discussed in *KSR International Co. v. Teleflex Inc. et al.* (U.S. 2007), the determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. See *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 7, 1336-37 (Fed. Cir. 2005). The legal conclusion, that a claim is obvious within § 103(a), depends on at least four underlying factual issues set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17 (1966): (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations.

Therefore, the test for obviousness under §103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir.1985). The Examiner must, as one of the inquiries pertinent to any obviousness inquiry under 35 U.S.C. §103, recognize and consider not only the similarities but also the critical differences between the claimed invention and the prior art. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir.1990). The fact that a reference teaches away from a claimed invention is highly probative that the reference would not have rendered the claimed invention obvious to one of ordinary skill in the art. *Stranco Inc. v. Atlantes Chemical Systems, Inc.*, 15 USPQ2d 1704, 1713 (Tex. 1990). When the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious. *Id.* p. 4 citing *United States v. Adams*, 383 U.S. 39, 51-51 (1966). Additionally, critical differences in the prior art must be recognized (when attempting to combine references). *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir.1990).

Moreover, the Examiner must avoid hindsight. M.P.E.P. § 2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984)). That is, the Examiner cannot use the Applicant's structure as a "template" and simply select elements from the references to reconstruct the claimed invention. See *In re Gorman*, 933 F.2d 982, 987, 18 U.S.P.Q.2d (BNA) 1885, 1888 (Fed. Cir. 1991). The fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01.

Furthermore, the Court in *KSR* reaffirmed that "[a] factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of argument reliant upon ex post reasoning." *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d at 1397. See also *Graham v. John Deere Co.*, 383 U.S. at 36, 148 USPQ at 474.

2) *Application of § 103 to the Rejected Claims - Combining the References Does Not Supply All Claim Elements:*

Claims 12 and 14-16:

Independent claim 12 has been amended to recite "disabling at least one previously-enabled size control function of said display window". As noted above, this language is supported by the Application, as originally filed. Thus, no new matter has been added.

The Office asserts that "Siler does not explicitly teach disabling at least one control function of the video presentation window ... [and that] Dwek teaches that the system does not permit a user to hide [an] advertisement presentation window on the display screen ...". However, this is not the same as teaching or suggesting the feature of disabling a previously-enabled display window size control function, claimed by the Applicant in independent claim 12. Bates also fails in this respect. Since none of the references disclose this claimed feature, then no combination of the references can supply this missing element, and claim 12 should be in condition for allowance. In addition, any claim depending from a nonobvious independent claim is also nonobvious. See M.P.E.P. § 2143.03. Therefore, claims 14-16 should also be in condition for allowance, and the Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 12 and 14-16 under 35 U.S.C. § 103(a).

Claim 23:

The Office asserts that “Zigmond ... does not explicitly teach disabling at least one control function of a display window ... [and that] Dwek teaches disabling control function of a display window displaying advertisements such as hiding the advertisement presentation window no the screen ...”. Once again, neither reference teaches or suggests the feature of disabling a previously-enabled display window size control function, as claimed by the Applicant in independent claim 23. Since none of the references disclose this claimed feature, then no combination of the references can supply this missing element, and claim 23 should be in condition for allowance. Therefore, the Applicant respectfully requests reconsideration and withdrawal of the rejection of claim 23 under 35 U.S.C. § 103(a).

CONCLUSION

The Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone the Applicant's attorney at (210) 308-5677 to facilitate prosecution of this Application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

SCHWEGMAN, LUNDBERG & WOESSNER, P.A.
P.O. Box 2938
Minneapolis, MN 55402
(210) 308-5677

Date April 23, 2008

By Mark V. Muller
Mark V. Muller
Reg. No. 37,509

CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 23 day of April 2008.

John D. Gustafson-Wentzell

Name

John D. Gustafson-Wentzell

Signature